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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,463	01/05/2006	Kimoon Kim	1751-393	1347
6449 7590 04/06/2009 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
GROSS, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
1639				
NOTIFICATION DATE		DELIVERY MODE		
04/06/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

### Office Action Summary

**Application No.**

10/563,463

**Applicant(s)**

KIM ET AL.

**Examiner**

CHRISTOPHER M. GROSS

**Art Unit**

1639

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Responsive to communications entered 12/30/2008. Claims 1-9 are pending. Claims 4-6 are withdrawn. Claims 1-3,7-9 are examined herein.

#### ***Priority***

The present application was filed on 1/5/2006 and is a 371 of PCT/KR04/01652 filed 07/05/2004.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) to Korean patent 10-2003-0045523 filed 07/05/2003. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Withdrawn Objection(s) and/or Rejection(s)***

The rejection of claims 1,2,7-9 under 35 U.S.C. 103(a) as being unpatentable over **Kim et al II** (US Patent 7388099 – referred to as '099) in view of **Richter et al** (US Patent Application 2004/0147396 – PTO 892 4/9/2008) is hereby withdrawn in view of applicant's evidence concerning co-ownership of '099 and the present application and invocation of the 35 USC 103(c) "shield."

#### ***Maintained Claim Rejection(s) - 35 USC § 102***

Claims 1,3,7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kim et al** (US Patent Application 2006/0207938; referred to as '938).

#### ***Response to Arguments***

On p 2 of applicant's remarks entered 12/30/2008, applicant argues that the 35 USC 102(e) date of the '938 application is 2/11/2004 whereas the present application claims foreign priority of Korean application 10-2003-0045523 filed 07/05/2003, precluding '938 as prior art.

In this vein it is noted the effective US filing date of the present application is 7/5/2004 and therefore '938 constitutes prior art under 35 USC 102(e).

It is further noted that '938 constitutes an intervening reference between the US filing date (7/5/2004) and the Korean filing date (7/5/2003). If applicant wishes to rely on the Korean filing date to overcome this rejection, a certified English translation of Korean application 10-2003-0045523 is required.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15

Claims 1-3,7-9 are rejected under 35 U.S.C. 102(a) as being anticipated by **Jon et al** (2003 JACS 125:10186-10187 – IDS entry 6/30/2008)

***Response to Amendment***

The declaration under 37 CFR 1.132 filed 12/30/2008 is insufficient to overcome the rejection of claim 1-3,7-9 based upon **Jon et al** (2003 JACS 125:10186-10187) as set forth in the last Office action because the inventive entity remains distinct from that of **Jon et al**.

***Response to Arguments***

In the paragraph bridging pp 2-3 of applicant's remarks entered 12/30/2008, applicant argues the included 37 CFR 1.132 declaration precludes Jon et al as prior art under 35 USC 102(a) because the reference describes the inventor's own work [i.e. is *not* by another].

It is noted the declaration provides evidence that authors Soo-Young Kim, Young Jin Jeon and Jae Wook Lee did not make an inventive contribution to presently claimed subject matter. However, the inventive entity of the present case includes Woo Seong Jeon and Kangkyun Baek who are not listed as authors. Therefore the inventive entity of the present application differs from that of Jon et al - even in view of said declaration - and consequently the reference is still considered by "another."

***Maintained and Updated Claim Rejection(s) – Double Patenting***

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of US Patent 7504029 (formerly copending Application No. 10/544,850).

***Response to Arguments***

On p 4 of applicant's remarks entered 12/30/2008, applicant states they will address the provisional rejection once the conflicting claims are in fact patented.

It is noted however, Application No. 10/544,850 has passed to issue as US Patent 7504029, therefore this rejection is no longer provisional and accordingly the rejection can not be held in abeyance.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER M. GROSS whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571 272 0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit: 1639

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Christopher M Gross  
Examiner  
Art Unit 1639

cg

/JD Schultz/

Supervisory Patent Examiner, Art Unit 1635